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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,298	11/22/2000	Michelle Q. Wang Baldonado	1508-3180	8440
7590 11/17/2004				
NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603			EXAMINER SALAD, ABDULLAH ELMI	
			ART UNIT 2157	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/717,298

Applicant(s)

BALDONADO, MICHELLE Q.
WANG

Examiner

Salad E Abdullahi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Response to Amendment

1. The amendment filed on 8/4/2004 has been received and made of record.
2. The response filed on 9/7/2004 has been received made of record.
3. applicant's argument with respect to claims 1-21 have been considered but are moot in view of new ground of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 13-18 rejected under 35 U.S.C. 101 because the claims are directed "information readable media" not tangible embodied on a computer readable medium.
6. Claim 13-18, are non-statutory because " an information readable media" alone has set no definition. A statutory product with descriptive material must include positive recitation of the computer readable medium.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.

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1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting").

7. Applicant's response to examiner's objection to claims 5, 11 and 17 are persuasive and objection to the claims 5, 11 and 17 is withdrawn.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-12, 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horibe U.S. Patent No. 6,101, 532 .

As per claim 1, Horibe discloses an electronic message management system

(10) comprising:

- a related message determination device (120) that determines one or more related electronic messages to a new electronic message (extracting

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related messages to a new or reply message) (see figs. 3a-4, col. 2, lines 40-54 and col. 4, lines 54-63 and col. 6, lines 20-49);

- a message control device (220) that assembles (merging) the one or more related electronic messages (see col. 3, lines 15-17, col. 5, lines 12-16 and col. 8, lines); and
- a message display device (140) that simultaneously displays a portion (title) of the one or more related electronic messages (see fig. 4 and col. 2, lines 40-54 and col. 7, lines 35-58, where when reply bottom is selected message one and related message are displayed).

Horibe is silent regarding: non-disruptively displaying the one or more related message.

Nonetheless, non-disruptively displaying the one or more related message would have been an obvious modification to Horibe's system. Furthermore, Horibe teaches a related message tree where when a first message is clicked or displayed a message tree of related messages is simultaneously displayed (see fig. 4 and col. 7, lines 44-58). Hence, by displaying a message tree of related messages without extra steps to see the related messages one skilled in the art would have readily recognized Horibe non-disruptively displays one or more related messages. In addition, non-disruptively displaying related data would be beneficial to Horibe's system as this makes it easy for the user to quickly and efficiently display related messages. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to non-disruptively display the one or more related message, thus providing a significant advantage

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of automatically predicting and displaying related messages more quickly and efficiently.

As per claim 2, Horibe discloses the system of claim 1, further comprising an electronic message composition device (140) that allows a user to at least one of create or update the new electronic message (see col. 4, lines 30-42).

As per claim 3, Horibe disclose the system of claim 2, wherein the related message determination device (120) automatically determines the one or more related electronic messages after commencement of the creating or updating of the new electronic message (see col. 4, lines 54-63);

As per claim 4, Horibe discloses the system of claim 1, wherein upon selection of a portion of one of the one or more related messages, the related message is displayed (see fig. 4, and col. 7, lines 35-57).

As per claim 5, Horibe discloses the system of claim 1, wherein the related message determination is based on at least one of: a statistical analysis; a comparison of the new electronic message to at least one of the one or more related electronic messages; a keyword search (see col. 5, lines 7-11); an address field search; a recipient search; a sender search; a subject field search; a date search; and a relevancy search (see figs. 3a-4, col. 4, lines 54-63 and col. 6, lines 20-49).

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As per claim 6, Horibe discloses the system of claim 1, wherein the one or more related electronic messages are at least one of: displayed in a new user interface; assembled (merged) into a digest; and stored (see col. 4, line 54 to col. 5, line 5).

As per claim 7, Horibe discloses an electronic message management method comprising:

- determining one or more related electronic messages to a new electronic message (see figs. 3A-3d and col. 7, lines 35-57);
- assembling (merging) the one or more related electronic messages (see col. 5, lines 12-16 and col. 8, lines); and
- displaying a portion of the one or more related electronic messages (see fig. 4 and col. 2, lines 40-54 and col. 7, lines 35-58, where when reply bottom is selected related messages are displayed).

Horibe is silent regarding: non-disruptively displaying the one or more related message.

Nonetheless, non-disruptively displaying the one or more related message would have been an obvious modification to Horibe's system. Furthermore, Horibe teaches a related message tree where when a first message is clicked or displayed a message tree of related messages is simultaneously displayed (see fig. 4 and col. 7, lines 44-58). Hence, by displaying a message tree of related messages without extra steps to see the related messages one skilled in the art would have readily recognized Horibe non-disruptively displays one or more

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related messages. In addition, non-disruptively displaying related data would be beneficial to Horibe's system as this makes it easy for the user to quickly and efficiently display related messages. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to non-disruptively display the one or more related message, thus providing a significant advantage of automatically predicting and displaying related messages more quickly and efficiently.

As per claim 8, Horibe discloses the method of claim 7, further comprising creating or updating the new electronic message (see col. 4, lines 30-42).

As per claim 9, Horibe discloses the method of claim 8, wherein determining the one or more related electronic messages automatically occurs after commencement of creating or updating of the new electronic message (see figs. 3a-4, col. 4, lines 54-63 and col. 6, lines 20-49).

As per claim 10, Horibe discloses the method of claim 7, wherein upon selection of a portion of one of the one or more related messages, the related message is displayed (see fig. 4, and col. 7, lines 35-57).

As per claim 11, Horibe discloses the method of claim 7, wherein the related message determination is based on at least one of: a statistical analysis; a comparison of the new message to at least one of the one or more related

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electronic messages; a keyword search (see col. 5, 7-11); an address field search; a recipient search; a sender search; a subject field search; a date search; and a relevancy search (see figs. 3a-4, col. 4, lines 54-63 and col. 6, lines 20-49).

As per claim 12, Horibe discloses the method of claim 7, wherein the one or more related electronic messages are at least one of: displayed in a new user interface; assembled into a digest; and stored (see col. 4, line 54 to col. 5, line 5).

As per claim 19, Horibe disclose an electronic message management system (10) comprising:

- a data system (100) for identifying data in electronic messages, the data system adapted to identify related electronic messages(see figs. 3A-3d and col. 7, lines 35-57);
- a message control system associated with the data system, the message control system adapted to assemble the related electronic messages(see col. 5, lines 12-16 and col. 8, lines); and
- an output device (display unit 140) adapted to communicate the related electronic messages (see col. 4, line 30-42, fig. 9, and col. 9, lines 16-39).

Horibe is silent regarding: non-disruptively displaying the one or more related message.

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Nonetheless, non-disruptively displaying the one or more related message would have been an obvious modification to Horibe's system. Furthermore, Horibe teaches a related message tree where when a first message is clicked or displayed a message tree of related messages is simultaneously displayed (see fig. 4 and col. 7, lines 44-58). Hence, by displaying a message tree of related messages without extra steps to see the related messages one skilled in the art would have readily recognized Horibe non-disruptively displays one or more related messages. In addition, non-disruptively displaying related data would be beneficial to Horibe's system as this makes it easy for the user to quickly and efficiently display related messages. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to non-disruptively display the one or more related message, thus providing a significant advantage of automatically predicting and displaying related messages more quickly and efficiently.

As per claim 20, Horibe disclose the electronic message management system of claim 19 wherein the data system further includes a rule and the data system identifies related electronic messages according to the rule (same subject matter) (see col. 5, lines 12-17).

As per claim 21, Horibe disclose the electronic message management system of claim 19 wherein the output device communicates in at least one of a human

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readable and computer readable format (see col. 4, line 30-42, fig. 9, and col. 9, lines 16-39).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 571-272-4009. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached 571-272-4009. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


Any response to this action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to: (703) (872-9306).


Abdullahi Salad
Examiner Art unit 2157
1/12/2004